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In re application of

Nagai et al.

Serial No. 10/662,809

Filed: September 16, 2003

For: METHOD FOR PRODUCING GROUP III NITRIDE COMPOUND
SEMICONDUCTOR SUBSTRATE

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed April 2, 2007.

On December 15, 2006, a non-final office action was mailed to applicant rejecting all of the claims under 35 USC 103 over the Tischler reference. A reply to the office action was filed by applicants on March 13, 2007. In the reply, applicants did not amend the previously presented claims and added new claims. A final office action was mailed by the office on April 2, 2007 containing new grounds of rejection. On April 5, 2007, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the April 2, 2007 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

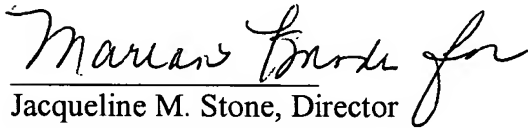
Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the non-final rejection of December 15, 2005, Claims 1, 3-4, 6-15, and 17-18 were rejected over Tischler. In the amendment filed by applicants, Claims 1, 3-4, 6-15, and 17-18 were not amended and Claims 19-20 were added. The examiner established a new grounds of rejection of claims 1, 3-4, 6-15, and 17-20 over Tischler in view of Shibata in the final office action of April 2, 2007. The petitioner argues that since the reply of March 13, 2007 did not amend Claims 1, 3-

4, 6-15, and 17-18, the new grounds of rejection of those claims over Tischler in view of Shibata, in the Final office action, was not necessitated by amendments. Petitioner's argument that the new grounds of rejection were not necessitated by Applicant's amendments is persuasive.

Because the rejection of claims 1, 3-4, 6-15, and 17-18, based on a new ground of rejection, was not necessitated by amendment, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response continues to run from April 2, 2007. Extensions of time may be obtained to file any amendments.



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